



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/583,516	05/31/2000	MICHAEL L EMENS	AM9-99-0118	2490

22891 7590 06/03/2003

DELIO & PETERSON  
121 WHITNEY AVENUE  
NEW HAVEN, CT 06510

EXAMINER

ALVAREZ, RAQUEL

ART UNIT	PAPER NUMBER
----------	--------------

3622

DATE MAILED: 06/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/583,516

Applicant(s)

EMENS ET AL.

Examiner

Raquel Alvarez

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-23 and 25-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-23,25-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

Art Unit: 3622

### **DETAILED ACTION**

1. This office action is in response to communication filed on 3/17/2003. Claims 4 and 24 have been canceled. Claims 1-3 and 5-23 and 25-37 are presented for examination.

#### **Claim Rejections - 35 USC § 112**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-3, 5-15, 22-23, 25, 32-33 and 34-37 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is lack of written description to support how a keyword is produced from the search result. Is the keyword being produced the same as the input produced by the user or is it a new keyword? For purpose of examination, prior art has been applied to the keyword being the same keyword produced by the user.

#### **Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 3622

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 2-3 5-12, 15-20, 22-29, 31-36 rejected under 35 U.S.C. 102(b) as being anticipated by Skillen et al.(Wo 98/36366, hereinafter Skillen).

With respect to claims 1, 3, 22, Skillen teaches a method for targeting an associated advertisement from an Internet search having access to an information repository by a user (Abstract). Producing at least one keyword from a search result of said Internet search by said user (i.e. a traditional keyword search in the Internet produces a search result and the associated keyword is used to match the keyword to a product data 24 of database 20)(page 7, lines 16-25); searching for said associated advertisement within said repository using said at least one keyword(page 7, lines 16-25); identifying said associated advertisement from said repository having a word that matches said at least one keyword(page 7, lines 16-25); and correlating said advertisement with user search result items (page 7, lines 16-25).

With respect to claims 2, 5 and 23, Skillen further teaches providing the advertisement on demand by said user (page 8, lines 12-22).

With respect to claims 6 and 26, Skillen teaches designating user search result items matched to said associated advertisements for subsequent selection by user (page 7, lines 34-, page 8, lines 1-3).

With respect to claims 7-12, 27-29 Skillen further teaches submitting a query to said information repository and obtaining said individual search result items as an URL (page 7, lines 34, page 8, lines 1-3).

Art Unit: 3622

With respect to claims 16, 18, 31 and 35-36 Skillen teaches providing related advertisements for search result items from a search of an information repository (Abstract). A computer readable program code means for causing a computer to effect matching said result items to said related advertisements (page 7, lines 34-, page 8, lines 1-3); a computer readable program code means for causing a computer to effect designating each of said search result items that have said related advertisements matched therewith (page 7, lines 34-, page 8, lines 1-3); a computer readable program code means for causing a computer to effect providing a corresponding graphical user interface for each of said search result items so designated for subsequent selection by a user (i.e. the user can click on the search results); a computer readable program code means for causing a computer to effect searching and retrieving said related advertisements for one of said search result items when said corresponding graphical user interface is selected by said user (page 7, lines 34-, page 8, lines 1-3); and a computer readable program code means for causing a computer to effect formatting and displaying said related advertisements upon selection (page 7, lines 34-, page 8, lines 1-3).

With respect to claim 15 and 19, Skillen further teaches that the user interface comprises a product icon (page 8, lines 12-22).

With respect to claim 17, Skillen further teaches assigning an identifier for said user when said user submits a query to said information repository (page 8, lines 12-22).

Art Unit: 3622

Claim 20 is similar in scope as claims 9-12 and therefore rejected under similar rationale.

With respect to claim 25, Skillen further teaches displaying along with said search result a user-selectable icon containing a link to said associated advertisement (page 6, lines 35-, page 7, lines 1-9).

With respect to claims 32-34, Skillen further teaches formulating a list of the related advertisements and passing the list to the request server (page 9, lines 9-36).

**Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 13, 14, 21, 30 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Skillen.

With respect to claim 13, 21 and 30, the claims further recite an off-line batch process for identifying said related advertisements for said search result items. Skillen teaches on page 8, lines 23-33 maintaining a database of the search results for the users in order to find the best fit product advertisement for the user. Skillen doesn't specifically teach that the process is conducted off-line. Official notice is taken that off-line processing is old and well known. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included processing

Art Unit: 3622

the information off-line because such a modification would allow for the information to be analyzed at a later time.

Claim 14 further recites providing a true/false designator to a user indicating whether said related advertisements exist for said individual search results items. Since, Skillen teaches advertisements based on the individual search results items (see abstract and drawings) then it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included providing a true/false to the user if said related advertisements exist because such a modification would give the users a definite response that advertisements based on the search criteria used does or doesn't exist.

Claim 37 further recites assigning an identifier for said user when said query is submitted to said information repository. Official notice is taken that it is old and well known to assign identifiers in order to differentiate items or persons. For example, a user is given a social security number to identify a particular person. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included in the user's query submitted to said information repository of Skillen to assign an identifier because such a modification would provide the above mentioned advantage.

**Response to Arguments**

5. The 101 rejections to claims 1-5, 6-15 have been withdrawn in lieu of claims amendments to include the specific automated computer apparatus to carry out the invention (Internet).

The 101 rejections to claims 1-22 due to lack of utility has been withdrawn in lieu of amendments to the claims to produce a useful, concrete, and tangible result.

The 101 rejection to claim 32 has been withdrawn in lieu to the claim amendment to provide more specificity to the functional interrelationships between the claim elements that permit the computer program's functionality to be realized and to claim the means for performing these functions.

The 101 rejections to claims 34-37 have been withdrawn in lieu to the claims amendments to include a program product that comprises a computer usable medium that equal a usable readable medium using a computer to carry out the functions.

With respect to Applicant's arguments to the identifying an associated advertisements from the search result and not from the search argument, the examiner asserts that the claims don't specifically recite that the search keyword( search argument) entered by the user is not the same keyword as the keyword produced by the search result. In Skillen, the search argument (keyword) produces a search result consisting of the keyword and the search results and the **search argument** (keyword) **and search results its searched to the associate search engine 18 which then looks for a match in the product data 24 of the database 20** (page 7, lines 16-25).



Art Unit: 3622

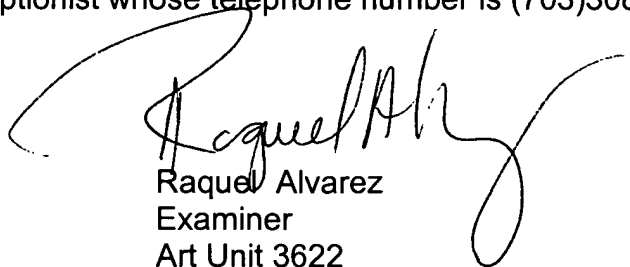
The Examiner overlooked and didn't apply art to dependent claims 36-37 in the previous office action and therefore it's making this office action non-final.

**Point of contact**

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (703)305-0456. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric w Stamber can be reached on (703)305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9326 for regular communications and (703)872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1113.



Raquel Alvarez  
Examiner  
Art Unit 3622

R.A.  
May 30, 2003